

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte NAOYASU MIYAGAWA and YASUHIRO GOTOH

Application No. 09/420,603¹

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER



This application was received at the Board of Patent Appeals and Interferences on August 14, 2003. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing is identified below.

¹ Application filed October 19, 1999, for reissue of U.S. Patent No. 5,235,581 (Application No. 08/396,981, filed March 1, 1995).

Claims 36 and 38 through 45 have been rejected under 35 U.S.C. § 251 as attempting to recapture subject matter surrendered in the application to obtain the original patent. A precedential opinion concerning a reissue recapture rejection under 35 U.S.C. § 251 was decided May 29, 2003 in Ex parte Eggert.² In Eggert, the court applied the fact-specific analysis set forth in In re Clement, 131 F.3d 1464, 1468-71 45 USPQ2d 1161, 1164-66 (Fed. Cir. 1997), determined that under the facts and circumstances before the it the “surrendered subject matter” was claim 1 of Eggert as that claim existed prior to the post-final rejection amendment that led to the allowance of claim 1 in the original patent, and decided that reissue claims 15-22 of Eggert were not precluded (i.e., barred) by the “recapture rule.” Slip. op. at 39-45. Thus, the decision in Ex parte Eggert needs to be applied to the determination whether the 35 U.S.C. § 251 rejections in the current case are appropriate.

Accordingly, it is

ORDERED that the application is returned to the examiner for a determination of whether the rejection of claims 36 and 38 through 45 under 35 U.S.C. § 251 remains appropriate in view of Ex parte Eggert.

If the examiner determines that the rejection under 35 U.S.C. § 251 remains appropriate, the examiner is authorized to prepare a supplemental examiner's answer specifically addressing the § 251 rejection. See 37 CFR § 1.193(b)(1). In the event

² A copy of the Eggert opinion is attached to this opinion. An electronic copy of Eggert is available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/RC010790.pdf>.

that the examiner furnishes a supplemental answer, the appellant may file a reply brief in accordance with 37 CFR § 1.193(b)(1).

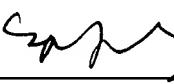
If the examiner determines that the rejection under 35 U.S.C. § 251 is no longer appropriate, the examiner should withdraw the rejection in an appropriate Office action.

If after action by the examiner in response to this Order there still remains decision(s) of the examiner being appealed, the application should be promptly returned to the Board of Patent Appeals and Interferences.

This application, by virtue of its "special" status, requires immediate action. See MPEP § 708.01.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:



Craig R. Feinberg
Program and Resource Administrator
(703) 308-9797

James E. Ledbetter, Esq.
Stevens Davis Miller & Mosher, L.L.P.
P.O. Box 34387
1615 L Street, NW, Suite 850
Washington, DC 20043-4387

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